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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,453	08/13/2001	Michael J. Tierney	017516-003230US	8762
20350 7.	590 09/17/2004		EXAM	INER
	AND TOWNSEND CADERO CENTER	PRIDDY, M	PRIDDY, MICHAEL B	
EIGHTH FLOO			ART UNIT	PAPER NUMBER
SAN FRANCIS	SCO, CA 94111-3834	1	3732	

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

· · · · · · · · · · · · · · · · · · ·		Application No.	Applicant(s)			
Office Action Summary		09/929,453	TIERNEY ET AL.			
		Examiner	Art Unit			
		Michael B Priddy	3732			
	The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply					
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).						
Status						
1)⊠ F	1)⊠ Responsive to communication(s) filed on <u>10 December 2003</u> .					
2a)□ □	This action is <b>FINAL</b> . 2b)⊠ This	action is non-final.				
•	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.					
Dispositio	on of Claims					
5)⊠ ( 6)⊠ ( 7)□ (	Claim(s) 22-26, 28, 29 and 31-33 is/are pending (a) Of the above claim(s) is/are withdray Claim(s) 22-26 and 31-33 is/are allowed. Claim(s) 28 and 29 is/are rejected. Claim(s) is/are objected to. Claim(s) are subject to restriction and/or	wn from consideration.				
Application	on Papers					
10)□ T	The specification is objected to by the Examine The drawing(s) filed on is/are: a) accomplicant may not request that any objection to the Replacement drawing sheet(s) including the correct The oath or declaration is objected to by the Example 2.	cepted or b) objected to by the drawing(s) be held in abeyance. Se tion is required if the drawing(s) is ob	e 37 CFR 1.85(a). jected to. See 37 CFR 1.121(d).			
Priority u	nder 35 U.S.C. § 119					
<ul> <li>12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</li> <li>a) All b) Some * c) None of:</li> <li>1. Certified copies of the priority documents have been received.</li> <li>2. Certified copies of the priority documents have been received in Application No.</li> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> </ul>						
2) Notice 3) Inform	(s) e of References Cited (PTO-892) e of Draftsperson's Patent Drawing Review (PTO-948) nation Disclosure Statement(s) (PTO-1449 or PTO/SB/08 No(s)/Mail Date 20031210	4) Interview Summary Paper No(s)/Mail D 5) Notice of Informal I 6) Other:				

### **DETAILED ACTION**

## Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al. (U.S. 6,699,177) in view of Ferre et al. (U.S. 6,738,656). Wang et al. teaches a surgical robotic system including a processor 46; a robotic manipulator 26 having a tool holder 45, the manipulator 26 moving the holder 45 in response to signals from a processor; a tool 82 having a surgical end effector 90/91; and an adapter 98 coupling the tool 82 to the holder 45, the adapter 98 maintaining sterile separation between the tool 82 and the holder 45. Hence Wang et al. teaches all of the limitations of the present invention except first and second sensors which transmit first and second signals to the processor from a magnetic switch that is magnetically actuated by a magnet of the tool.

Ferre et al. teaches a system including first and second sensors 78 which transmit first and second signals to the processor from a magnetic switch that is magnetically actuated by a magnet 80 of the tool 60. It would have been obvious to one of ordinary skill in the art at the time of the present invention to have included sensors in the adapter of Wang et al. which transmitted signals to the processor from the magnet

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on the tool to identify which of a plurality of medical instruments is attached to the adapter. "Knowing the identity of the attached medical instrument permits the system of automatically adjust the position detection unit to compensate for differences in instrument tip position with respect to the position of the sensors for a variety of medical instruments." (lines 26-31 of column 6)

## Allowable Subject Matter

Claims 22-26 and 31-33 are allowed.

### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is (703) 308-8620. The examiner can normally be reached on Mon.-Fri. 8 a.m. - 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael B. Priddy

September 15, 2004